

### **Remarks**

Reconsideration and withdrawal of the rejections of the claims, in view of the amendments and remarks herein, is respectfully requested. Claims 1, 35, 40, 47, 55-56, and 107 are amended, claims 4, 28-34, 53-54, and 79-86 are canceled, and claims 110-120 are added; as a result, claims 1-3, 5-27, 35-52, 55-78 and 87-120 are now pending in this application. The amendments are intended to advance the application and are not intended to concede to the correctness of the Examiner's position or to prejudice the prosecution of the claims prior to amendment, which claims are present in a continuation of the present application.

With regard to new claims 110-120, the Examiner is requested to consider that those claims are directed to a compound having a biotin functional group.

### **The 35 U.S.C. § 112 Rejections**

The Examiner rejected claims 1-11, 15 and 107-109 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner also rejected claims 1-11, 15 and 107-109 under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for a method of synthesizing the compounds of formulas I and IV-XXVIII and those shown in Figure 7, allegedly does not reasonably provide enablement for a method of synthesizing any compound of formula R-L-A-X. These rejections are respectfully traversed.

The amendments to claim 1 further describe the compound of formula (I) having R-linker-A-X. However, as any functional group (R) can be employed along with linker-A-X, and Applicant describes numerous functional groups (see pages 47-51 and claims 10-13 and 15) and linkers (see pages 51-55, and claims 5, and 7-8), as well as compounds falling within the scope of formula (I), including those with different R groups, one of skill in the art would be apprised that Applicant was in possession of the claimed genus.

With respect to methods of synthesizing compounds of formula (I), Applicant provides detailed guidance on syntheses at pages 55-68 of the specification. Moreover, as evidenced by Barrett et al. (U.S. Patent No. 6,416,733), Akiyama et al. (J. Chem. Soc. Perkin Transactions, 2: Physical Org. Chem., 9:1213 (1989)), and Cheuk et al. (Polymeric Materials Science and

Engineering, 82:56 (2000)) (documents cited against the claims under 35 U.S.C. § 102), methods of preparing those compounds were well known to the art.

Therefore, withdrawal of the 35 U.S.C. § 112, first paragraph, rejections, is respectfully requested.

*The 35 U.S.C. § 102 Rejections*

The Examiner rejected claims 1, 4-5, 7, 11, and 15 under 35 U.S.C. § 102(e) as being anticipated by Barrett et al. (U.S. Patent No. 6,416,733). The Examiner also rejected claims 1, 3-5, 7, 11, and 15 under 35 U.S.C. § 102(b) as being anticipated by Akiyama et al., (J. Chem. Soc. Perkin Transactions 2: Physical Org. Chem., 9:1213 (1989)). The Examiner further rejected claims 1, 3-5, 7, 10-11, and 15 under 35 U.S.C. § 102(b) as being anticipated by Cheuk et al. (Polymeric Materials Science and Engineering, 82:56 (2000)). These rejections, as they may be maintained with respect to the pending claims, are respectfully traversed.

In particular, to support the rejections, the Examiner points to N-benzyloxy carbonyl-11-iodo-3,6,9-trioxaundecylamine at column 78, line 60-column 79, line 7 in Barrett et al.; 5,8,11-trioxa-2azatridecanoic acid, 13-bromo-2-(phenylmethoxy)-2,2,2-trichloroethyl ester and acetamide, N-[2-[2-[2-(2-bromoethoxy)ethoxy]ethoxy]ethyl]-N-(phenylmethoxy) at page 1213 in Akiyama et al.; and L-phenylalanine, N-(4-ethynylbenzoyl)-, 2-[2-(2-chloroethoxy)ethoxy]ethyl ester at page 56 in Cheuk et al. However, none of those compounds include a *n*-alkylene group, having 4-10 carbon atoms (i.e., (CH<sub>2</sub>)<sub>4-10</sub>), which is linked to a halide.

Accordingly, withdrawal of the § 102 rejections is respectfully requested.

### CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6959 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of January, 2006.

Name

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